



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,783	11/01/2000	Yoshitaka Nakamura	P/2856-18	2457

7590 03/10/2004

STEVEN I WEISBURD ESQ
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS
41st FLOOR
NEW YORK, NY 10036-2714

EXAMINER

HESELTIME, RYAN J

ART UNIT PAPER NUMBER

2623

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,783

Applicant(s)

NAKAMURA ET AL.

Examiner

Ryan J Hesseltine

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-8 and 11-13 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species I in Paper No. 6 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The abstract of the disclosure is objected to because the reference numeral 180 refers to both an enclosure of the portable information terminal device and the lens selection means. Figure 4 shows the lens selection means having reference numeral 180 and the first enclosure having reference numeral 104. Perhaps applicant intended to refer to reference numeral 170 in conjunction with the enclosure as shown in Figure 3 and on page 5. Correction is required. See MPEP § 608.01(b).
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Portable Information Terminal Device Using a Single Imaging Element to Perform Identity Verification."

Claim Objections

5. Claim 3 is objected to because of the following informalities: page 25, line 12-14 states, "said second lens and said imaging element are arranged in one raw when said first and second..." (emphasis added). The examiner believes that applicant intended this to read "said imaging element are arranged in one row...". Appropriate correction is required.

Art Unit: 2623

6. Claim 5 is objected to because of the following informalities: page 25, line 27-29 states, "said first lens is disposed between said first window and said imaging element when said first and second enclosures being in an open condition" (emphasis added). The examiner believes that applicant intended this to read, "said first lens is disposed between said second window..." in accordance with Figures 1 and 6, and page 14, line 7-12. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robb (USPN 6,177,950, newly cited) in view of Borza (USPN 5,680,205).

9. Regarding claim 1, Robb discloses a portable information terminal device (multiphone 20) comprising: an enclosure (rectangular body) of said portable information terminal device (Figure 1; column 5, line 24-36), an imaging element (reading head, camera 2) provided within said enclosure (column 5, line 36-47), a first lens (93) provided within said enclosure for said imaging element, a second lens (94), a focal length of which being shorter than that of said first lens (column 3, line 50-column 4, line 13), provided within said enclosure for said imaging element, a lens selection means (motor 65 or thumbwheel 3), provided within said enclosure, for selecting one of said first lens and said second lens so that a focal point of a selected lens is established at said imaging element (Figure 6; column 10, line 33-58).

Art Unit: 2623

10. Robb discloses that with the reading head in position 3, the user may capture data and/or images below the device such as fingerprints and signatures (column 3, line 64-column 4, line 3), and that the system preferably includes some form of user verification such as a signature or a fingerprint, but does not explicitly disclose a transparent plate to which a tip of a finger of an user of said portable information terminal device is attached, wherein said imaging element captures an image of a fingerprint of said tip of the finger on said transparent plate by said second lens selected by said lens selection means. Borza discloses a fingerprint imaging apparatus with auxiliary lens including a transparent plate (prism 26) to which a tip of a finger of a user of said device is attached, wherein an imaging element (28) captures an image of a fingerprint of said tip of the finger on said transparent plate (prism 26) by a first lens (21) selected by said lens selection means (rotatably mounted inner mounting plate 16, Figure 1a; column 2, line 27-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to capture an image of a fingerprint of a finger attached to a transparent plate by a lens selected by lens selection means as taught by Borza in order to verify a person's identity using a small video camera including an auxiliary lens to allow the camera to be used selectively for imaging object in the neighborhood of the apparatus, as well as for producing fingerprint images (column 1, line 36-42).

Allowable Subject Matter

11. Claims 2-8 and 11-13 are allowed.

12. The following is a statement of reasons for the indication of allowable subject matter: regarding independent claim 2, the prior art of record does not teach or suggest a portable information terminal device having a lens selection means which, in response to an opening and

Art Unit: 2623

closing operation of first and second enclosures, selects one of a first lens and second lens, so that, in an open condition a focal point of said first lens is established at an imaging element, and in a closed condition a focal point of said second lens is established at said imaging element; regarding independent claim 3, the prior art of record does not teach or suggest a portable information terminal device having a first window provided on a front surface of a second enclosure for an imaging element and having a keyboard thereon, and a second window provided on a front surface of a first enclosure, said front surface thereof being opposite to said front surface of said second enclosure, when both of said enclosures being attached to each other, wherein a transparent plate (to which a top of a finger of a user is attached), said first window, said second lens, and said imaging element are arranged in one row when said first and second enclosures are contacted to each other to form a closed condition.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- USPN 6,069,648 to Suso et al. discloses an information communication terminal device including a video camera.
- USPN 6,088,585 to Schmitt et al. discloses a portable telecommunication device including a fingerprint sensor and related methods.
- USPN 6,104,922 to Baumann discloses user authentication in a communication system utilizing biometric information.
- USPN 6,181,381 to Evans discloses a camera lens within a pivoting hinge in a portable electronic device.

Art Unit: 2623

- USPN 6,249,672 to Castiel discloses a portable telephone including biometric recognition such as fingerprint validation.
- USPN 6,308,084 to Lonka discloses a mobile communications device with a camera.
- USPN 6,424,845 to Emmoft et al. discloses a portable communication device including a biometric sensor.
- USPN 6,466,202 to Suso et al. discloses an information terminal unit including a camera and see-through liquid crystal display.
- USPN 6,473,631 to Siddoway et al. discloses a video swivel phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069.

The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rjh

JINGGEWU
PRIMARY EXAMINER